

Application No.: 10/085,139

Docket No.: 22129-00005-US

REMARKS

Receipt of the Office Action mailed June 23, 2003 is acknowledged. No claims are amended, deleted or canceled. Favorable reconsideration of claims 1-19 is earnestly solicited in view of the instant remarks.

Claims 1, 2, 4, 5, 7, 8, and 10 to 19 stand rejected under 35 U.S.C. 102 (b) as allegedly being anticipated by U.S. Patent No. 5,863,669 (Miller) (= to EP 0718 072A1 cited in Applicants Information Disclosure Statement). This rejection is respectfully traversed for at least the following reasons.

As the examiner stated in the Action, Miller discloses a brazing sheet having an aluminum alloy core material and a clad layer on the core material. However, it is respectfully submitted that the ranges of alloying elements (Mn, Cu, Mg, Si, Fe, Ti, Cr, Zr, V) disclosed by Miller fail to anticipate the ranges in the present claims under 102(b). That is, contrary to the Examiner's cursory conclusion, the prior art range fails to teach or suggest the composition ranges as claimed with sufficient specificity. See MPEP 2131.03 and Ex parte Lee, 31 USPQ2d 1005 (Pd. Pat. App. & Inter. 1993). Namely, that "sufficient specificity" has been held by the Federal Circuit to be that when a reference discloses multiple ranges of multiple elements, in order for a reference to anticipate under 102, that reference must describe to one of skill in the art to make the selection as claimed from among the many possible candidates. See, e.g., Merck & Co. v. Biocraft Labs., Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); In re Kollman, 595 F.2d 48, 55, 201 USPQ 193, 198 (CCPA 1979); In re Petering, 301 F.2d 676, 681, 133 USPQ 275, 279 (CCPA 1962). When a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. Mendenhall v. Astec Industries, Inc. 13 USPQ2d 1913, 1928 (Tenn 1988), aff'd 13 USPQ2d 1956 (Fed. Cir. 1989).

Here, Miller discloses a myriad of many possible compositions that could be made within the broad ranges of Mn from 0.7-1.5, Cu from 0.2-2.0, Mg 0.1-0.6, Si >0.15, Fe up to 0.8, and Ti, Cr, Zr and/or V optional. Applicants' claim 1, on the other hand, is directed to a core alloy

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comprising: Si < 0.2 %, Fe < 0.2 %, Mn: 1.3 – 1.7 %, Mg: 0.4 - 0.8 %, Cu: 0.3 – 0.7 %, Ti < 0.2 % and at least one element selected from the group consisting of Cr, Sc, V, Zr, Hf, and Ni, and balance Al and impurities. None of Miller's examples are anywhere close to meeting the ranges claimed in the present claim 1. That is, Miller's examples all employ 1.1 % Mn, while Applicants' claims recite 1.3-1.7. Similarly, Miller's inventive examples employ 0.5% Si, while Applicants' claims recite less than 0.2%. Indeed, Miller's comparisons examples are made with 0.1% Si, while the inventive examples are made with 0.5%. There is no chance that one of skill in the art would have selected the ranges as claimed such that Miller would be found by a court to be an anticipation of the instant claims.

The dependent claims (in addition to those that were already indicated to be allowable by the Examiner) are further patentable since Miller fails to teach or suggest the claimed properties and additional further features recited therein. For example, claims 11-15 and 19 recite specific yield strength values. Indeed, Miller teaches to raise the Si content in order to improve properties such as corrosion resistance and yield strength, while the instant claims are directed to materials wherein Si is maintained at about 0.2% or lower. To find anticipation of claims, the prior art embodiments must possess the properties expressly recited in the claims. E.I. du Pont de Nemours & Co v. Phillips Petroleum Co. 849 F.2d 1430, 7 USPQ2d 1129 (Fed Cir 1989). Since none of the examples of Miller are within the claimed ranges, there is no basis for the Examiner's apparent conclusion that the claimed properties would have been inherent. Indeed, Miller shows better properties when Si is increased, not decreased. The instant rejection is therefore improper and should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 22129-00005-US from which the undersigned is authorized to draw.

Dated: August 25, 2003

Respectfully submitted,

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